

PCT

00766.000046

PATENT APPLICATION

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HIROMASA MIYAJI ET AL.

Application No.: 09/763,793

Filed: February 27, 2001

For: NOVEL POLYPEPTIDE

) : Examiner: N/Y/A

) : Group Art Unit: N/Y/A

) : May 3, 2004

Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

REQUEST FOR CLARIFICATION  
OF DECISION ON PETITION


Sir:

Applicants received a Decision on Petition dated March 10, 2004 withdrawing the holding of abandonment in the above-identified application. A copy of the Decision is attached at Tab A.

In the Decision, at the last paragraph, it is noted Applicants will now receive a Notification of Missing Requirements for delayed filing of the oath or declaration. However, an executed Declaration accompanied the original filing; a copy of the Declaration as originally filed is enclosed at Tab B.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our below listed address.

Respectfully submitted,



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05 MAR 2004

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In re Application of  
MIYAJI et al.  
Application No.: 09/763,793  
PCT No.: PCT/JP99/04602  
Int. Filing Date: 26 August 1999  
Priority Date: 27 August 1998  
Attorney's Docket No.: 766.46  
For: NOVEL POLYPEPTIDE

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MAR 10 2004

DECISION ON PETITION

UNDER 37 CFR 1.181

This is in response to applicant's 03 December 2003 petition entitled "Petition under 37 CFR 1.137(a)" to withdraw holding of abandonment based on a failure to receive an office action, filed in the United States Patent and Trademark Office (USPTO), which is being treated as a petition under 37 CFR 1.181. Applicant alleges that he did not receive the an Office action mailed on 03 April 2001. Should their argument under 37 CFR 1.181 fail, applicant requests consideration under 37 CFR 1.137(a) or (b).

### BACKGROUND

On 27 February 2001, within the thirty month deadline, applicant filed a transmittal letter requesting a filing under 35 U.S.C. 371. A review of the application file reveals that the "NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES" was mailed by the USPTO on 03 April 2001. The notification indicated that applicant must provide an initial or substitute computer readable form (CFR) of the 'Sequence Listing'.

On the same date (03 April 2001), a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that applicant had failed to provide the full U.S. Basic National Fee by the thirty month period.

### DISCUSSION

In order to establish that papers were not received, a petition under 37 CFR 1.181 with a proper showing is required. As set forth in the Official Gazette at 1156 OG 53, the petition must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in practitioner's statement). No petition fee is required.

Counsel for applicant states that he did not receive the Office communication mailed on 03 April 2001 and that a search of the file jacket and docket records indicates that the Office action was not received. Counsel also submitted a copy of "the Docket Record for the above

identified application where the nonreceived Office communication would have been entered had it been received and docketed. The Docket Record also shows all replies docketed (here, none) to date for this application..."

Attorney for applicant proffers that the mailing address used by the USPTO on the Notification To Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures and Notification of Abandonment (30 Rockfeller Plaza, New York, NY 10112) was in error since it did not include the name of the law firm and that this is the cause of his nonreceipt of said Notifications. Counsel states that the correct address (Fitzpatrick, Cella, Harper & Scinto, 30 Rockfeller Plaza, New York, NY 10112) is the address listed on the transmittal letter for entry in the U.S. national stage filed on 27 February 2001.

A review of the application file and the USPTO records indicates that counsel listed the "Fitzpatrick, Cella, Harper & Scinto, 30 Rockfeller Plaza, New York, NY 10112" address on the transmittal letter for this application. However, the USPTO PALM record incorrectly lists the incomplete correspondence address.

The Notification of To Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures mailed on 03 April 2001 and Notification of Abandonment mailed on 03 April 2001 is hereby vacated.

Per applicant's 03 December 2003 request, applicant's address will be corrected in the USPTO records to include the name of the law firm "Fitzpatrick, Cella, Harper & Scinto".

A review of the fees for this application reveals the following. Applicant's transmittal letter filed on 27 February 2001 requesting entry into the national stage indicates that a check for \$3,618 was enclosed. A review of the USPTO finance records does not indicate that any fees were paid in connection with this case. However, applicant did authorize that any deficiency be charged to his deposit account and provided the deposit account number. Therefore, the U.S. basic national fee will be charged to the deposit account per applicant's authorization. Thus, the application can not be considered to be abandoned for failure to pay the basic national fee by the thirty month period.

Applicant's petitions to revive under 37 CFR 1.137(a) or in the alternative, 37 CFR 1.137(b) are considered moot.

The itemized postcard receipt dated 27 February 2001 does not indicate that an oath or declaration was received with the initial filing. Hence, a Notification of Missing Requirements will be issued indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and the \$130 surcharge for filing the oath or declaration after the thirty month period are required.

### CONCLUSION

For the reasons presented above, the Petition to withdraw the holding of abandonment under 37 CFR 1.181 is **GRANTED**.

The Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures and the Notification of Abandonment (Form PCT/DO/EO/909) mailed on 03 April 2001 are hereby **VACATED**.

Applicants' correspondence address will be corrected in the USPTO records to include the name of the law firm "Fitzpatrick, Cella, Harper & Scinto".

The application will be forwarded to the United States Designated/Elected Office for further processing, including issuance of the Notification of Missing Requirements indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and the \$130 surcharge for filing the oath or declaration after the thirty month period is required.



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**COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR PATENT COOPERATION TREATY APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled Novel Polypeptide

the specification of which was filed as PCT International Application No. PCT/JP99/04602 on August 26, 1999 and was amended under PCT Article 19 on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) on which priority is claimed:

Country	Application No.	Filed (Day/Mo./Yr.)	Priority Claimed (Yes/No)
Japan	P. Hei. 10-241248	27/August/1998	Yes

I hereby appoint the practitioners associated with the firm and Customer Number provided below to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, and direct that all correspondence be addressed to the address associated with that Customer Number:

**FITZPATRICK, CELLA, HARPER & SCINTO**  
Customer Number: 05514

I hereby declare that all statements made herein of my own knowledge

11-35 WOI  
11/152 WOI  
K46-128903-922C/K1  
COMBINATION DECLARATION AND POWER OF ATTORNEY  
FOR PATENT COOPERATION TREATY APPLICATION

(Page 2)

are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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Inventor's signature \_\_\_\_\_  
Date \_\_\_\_\_ Citizenship/Subject of \_\_\_\_\_  
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Post Office Address \_\_\_\_\_

Full Name of Sixth Joint Inventor, if any \_\_\_\_\_  
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